

REMARKS

Claims 1-10 are pending and under consideration.

Claims 1, 3, 4, 6, 7, 9 and 10 are rejected under 35 USC § 103(a) as being obvious over U.S. Patent No. 5,887,964 to Higuchi et al. in view of U.S. Patent No. 5,771,328 to Wortman et al.

Recently, Examiner Nguyen kindly agreed to discuss the rejection with the undersigned. During this conversation, the relevance of Fig. 8 of Wortman et al. was discussed. The Examiner asserted that he is relying upon Figs. 3-7, not Fig. 8. The Examiner asserted that there is nothing in Wortman et al. that requires the Examiner to rely on Fig. 8. The Examiner further asserted that the issue relevant to the obviousness rejection is whether it would have been obvious to combine Figs. 3-7 of Wortman et al. with Higuchi et al., as detailed in the rejection.

To a large extent, the undersigned agrees with the Examiner. It is respectfully submitted that there is no motivation to combine the teachings of Figs. 3-7 of Wortman et al. with Higuchi et al. to produce the claimed invention.

The fact that the prior art teaches away from an invention is evidence that the invention is not obvious (see *Akzo v. USITC*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed.Cir.1986) and *In re Graselli*, 713 F.2d 731, 218 USPQ 769 (Fed.Cir.1983)).

"We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ 2d 1130 (Fed. Cir. 1994). If references taken in combination would produce a "seemingly inoperative device," we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244, 56 C.C.P.A. 823 (1969) (references teach away from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away)." (see *McGinley v. Franklin Sports Inc.*, 60 USPQ 2d 1001, 1010 (Fed. Cir. 2001))

Hindsight cannot be used in determining the issue of obviousness and the reviewer must view the prior art without reading into that art the teachings of the application or patent (see *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed.Cir.1983)).

"[T]he best defense against the subtle but powerful attraction of a hindsight-based

obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Wortman et al. teaches away from combining Figs. 3-7 with Higuchi et al. as suggested by the Examiner. Fig. 8 of Wortman et al. teaches that the elements 36 and 38 should not be provided on an emission face of a light guide plate. Fig. 8 of Wortman et al. teaches that, for a guide plate, in which the incidence face is a minor face, projections should be provided exterior to the guide plate, such as on the Wortman et al. light directing film 158.

Although Wortman et al. does not teach that the embodiment of Fig. 8 must be used, there is no motivation for combining the teachings of Figs. 3-7 with Higuchi et al., as set forth in the rejection. Fig. 8 teaches away from the combination. At least for this reason, the rejection should be withdrawn.

Claims 1-10 are rejected for obviousness-type double patenting over claims 3, 6 and 9 of U.S. Patent No. 6,339,458 ("the '458 patent"). The independent claims of the '458 patent recite that the major faces of the light guide plate include an emission promotion face on which first emission promotion regions and second emission promotion regions are intermingled according to a distribution, said second emission promotion regions having an emission promotion ability per unit area smaller than that of said first emission promotion regions or any of the other above mentioned limitations.

Dependent claims 3, 6 and 9 recite that the covering density of the second emission promotion regions tends to decrease according to distance from the incidence face. The claims of the present application do not disclose or suggest first and second emission promotion regions or any of the above mentioned limitations.

Independent claim 1 of the present application, for example, recites an emission face provided with a plurality of light scattering elements distributed according to a predetermined pattern, the emission face having a rough area formed on and around the light scattering elements such that the light scattering elements and an area surrounding the light scattering elements are roughened. Claims 3, 6 and 9 of the '458 patent do not disclose or suggest light scattering areas and a rough area, as claimed.

Claims 3, 6 and 9 of the '458 patent distinguish over claims 1-10 of the present application, and claims 1-10 of the present application distinguish over claims 3, 6 and 9 of the '458 patent. At least for these reasons, the obviousness-type double patenting rejection should be withdrawn.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: May 31 2005

By: Mark J. Henry
Mark J. Henry
Registration No. 36,162

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501